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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/875,753	06/06/01	VANCURA	0 1498/198(B)

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EXAMINER	
PIERCE, W	
ART UNIT	PAPER NUMBER
3711	4
DATE MAILED: 11/06/01	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

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# Office Action Summary

Application No.

09/875,753

Applicant(s)

VANCURA, OLAF

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1,3,8-10,18,19,24,25,30-33,35,41-43,47-50,55,56,58-71,73 and 75-87 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,8-10,18,19,24,25,30-33,35,41-43,47-50,55,56,58-71,73 and 75-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). **WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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**Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 19, 24, 25, 30, 42, 43, 47-50, 55 and 56 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 19, 24, 25, 30, 42, 43, 47-50, 55 and 56 of copending Application No. 09/372,560. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 8-10 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the copending claims Application No. 09/372,560. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terms "separate" and "incombination" do not clearly distinguish the scope of one claim from that of another. A predetermined range called for in the house percentage claim 1 of the '560 application is inherent to the design of a wagering game to having a favorable house percentage. The design of wagering games having house percentages are inherent and well known to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claim Rejections - 35 USC § 112**

Claims 1, 3, 8-10, 18, 19, 24, 25, 30-33, 35, 41-43, 47-50, 55, 56, 58-71, 73 and 75-87 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way

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as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It stated that, "In the specification, the game of chance is played "separately" form the bonus game and is not play in "combination" which implies the games are played simultaneously. The claim merely calls for the "playing the knowledge-based bonus game in combination with the bonus game". The scope of the claim implies that the games are played at the same time and not sequentially after one another as disclosed. Note fig. 2 where the flow chart shows the steps of the method to go from "play underlying casino game" , "stop play" and then to "play knowledge-based bonus game". This is a scope of claim problem.

Claims 1, 3, 8-9 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, in line with the rejection under 1st paragraph set forth above, the scope of the term "playing...in combination" recited in claim 1 is not clear. As set forth above, this is a scope of claim problem. It leaves the claim inferential and unclear since the steps required to play these games "in combination" are not recited.

***Claim Rejections - 35 USC § 102***

Claims 1, 3, 18, 42, 50, 55 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller and, in the alternative 2,197,974.

Claims 1, 3, 42, 50 and 58 are clearly shown. In Keller and '974, the game of chance stops when a prize has been determined or rewarded. At that point, the game of skill commences. Claims 18 and 55 are shown in that a player is payed a first prize if correctly answers and receives a second amount of no prize if incorrectly answers. In Keller, a player place a wager and receives a payout in tokens like a standard casino game. However, the tokens are not given any cash value and are only good for chances to play the game of skill. Specifically turning to claim 1, the steps of "receiving a wager" are shown in fig. 1 of Keller by "players can place stake in a casino game", "playing an underlying game of chance" is shown by "conduct casino game" and "playing a knowledge-based bonus game." by "conduct skill game. The house advantage is at the bottom of col. 2, lns 61-67 where a player is played "for the entertainment". The house advantage is nothing more than a percentage of the wager retained by the house for the privileges of playing the games. In view of the above, Keller meets the limitations of the claims. Subsequent

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limitations pertaining to house advantage are considered inherent in Keller. The "house advantage" is an old and well known concept to one of ordinary skill in the art. This is not a discovery of the applicant. The "house advantage" is a matter of choice and considered to be a balance between profit and player interest. The higher the "house advantage" (i.e. profit) the less player interest. In examining the claims, skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). The desire of a game designer to make a profit at playing the game as well as maintaining a player interest is presumed. In line with that, we must also take into account the not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In *re Preda*, 401 F.2d 825, 826 159 USPQ 342, 344 (CCPA 1968). Clearly we can expect that a game designer would avoid a game where the overall payouts are not profitable when compared to a players wagers. Such "payouts" are discussed in applicant's own C1 exhibit, for example.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10, 19, 24, 25, 30-33, 35, 47-49, 56, 59-71, 73 and 75-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller and/or 2,197,974 in view of Thompson.

As to claims 8, 47 and 61, neither of the above references show random stopping of the chance game. Thompson teaches that it would have been obvious to random conduct the steps of a game like those shown by Keller and '974 in order to add an element of surprise to the players. The setting of the house advantage in claim 9 and 10, 19, 25, 30-33, 35, 48, 49, 56, 59, 60, 62, 64 and 65-69 are obvious matters of design choice. Allowing a player to have more than on chance to answer a query and paying out accordingly as called for in claim 63 is old and not considered an advance in the art. To have only required a proximate answer in Keller of '974 would have been

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obvious in order to make it easier on the player. Claim 24 is shown in that a player is paid a first prize if correctly answers and receives a second amount of no prize if incorrectly answers. Claims 70, 71, 73, 75-79 and 82-85 are old to trivia type games. Claims 80, 81, 86 and 87 are treated as set forth above.

Claims 1, ~~3, 8-10~~, 18, 19, 24, 25, 30-33, 35, 41-43, 47-50, 55, 56, 58-71, 73 and 75-87 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker.

Walker clearly shows the wager, game of chance and trivia game. He discloses his play of the trivia game to occur "while the reels are spinning" (col. 3, ln. 26). Such is considered to be "in combination" from the play of the game of chance. A favorable house percentage that considers the level of skill of the players (i.e. the correctness of the answers) is inherent. See discussion above. The limitation is claim 19 and subsequent independent claims that "stopping play of the first game" is considered met since during the spinning of the wheels is considered "dead time" (col. 3, ln. 47) and the game of chance is not being played

Claims 1, 3, 8-10, 18, 19, 24, 25, 30-33, 35, 41-43, 47-50, 55, 56, 58-71, 73 and 75-87 are rejected under 35 U.S.C. 102(b) as being anticipated by 2,262,642.

As to claims 1, 3, 19, 25, 30, 42, 43, 47-50 and 58 shown is a slot 10 for receiving a wager, a casino slot machine and a trivia game (discussed on the bottom of his page 3) that is played separate and after the casino game. A favorable house percentage that considers the level of skill of the players (i.e. the correctness of the answers) is inherent. See discussion below in response to applicant's remarks made in the preliminary amendment. In line with this claims 9-11, 48, 49, 56, 94-96 are inherent since a game designer must determine and be aware of the "desired profitability" of the game he is designing. Scarne's Complete Guide to Gambling discusses house percentage and how a gaming operator would make or loose money by making determinations that affect house percentage (conventionally the house pays off a wager at less than the correct odds. However, the rules of play, such as a "push" or allowing the determination of a players hand in blackjack before the determination of the dealer can also affect the house percentage). Inherently all gaming operators avoid losing money. Clearly no operator of the '642 method would consider losing money. One must consider such is a matter of common knowledge and common sense of the person of ordinary skill in the art to consider the level of skill of a player as a variable in the conventional house percentage of the combined wagering game. (See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)) Such discussions of the "over-skillful players" is known in the art as taught by 2,253,569 at the bottom

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of pg. 2. Knowing that the over skilled player can result in a loss of income is considered to be part of the skill that is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). In evaluating a reference, it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In *re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In the instant case, the consideration of house percentage, so that a game makes money without decreasing player interest, is at the root of every wagering game. Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962). Clearly, an artisan would realize that a favorable house percentage would have to be designed for a game to make money in a casino environment. On pg. 2, Ins. 14-23 the trivia game is shown to be initiated by the "reel display", random or quasi random or a winning combination (pg. 2, ln. 4) as called for in claims 5-8, 91-93 Claims 14-18, 21-24, 52-55, 99-102 are drawn to quiz games. Examiner submits that such gaming formats are old and well known and inherent in the disclosure of '642.

#### **Conclusion**

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (703) 308-3551.


Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is [Customerservice3700@uspto.gov](mailto:Customerservice3700@uspto.gov).

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

  
WILLIAM M. PIERCE  
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.